Serial No.: 10/516,464

Docket No.: 28951.2183

REMARKS

Claims 16-30, as amended, remain herein.

Applicants believe that this amendment places this application fully in condition for

allowance, and surely places it in better condition for any appeal. Accordingly, entry of this

amendment and allowance of all claims are respectfully requested.

Applicants thank the Examiner for the interview of November 6, 2006. In that interview,

applicants' representative argued to the Examiner that the prior art fails to disclose a circuit that

electrically connects the card receiver and the compact memory card, as claimed by applicants.

It was also argued that Eisele does not disclose a card adapter having a first connector connecting

the card adapter to the card receiver, as claimed by applicants. Eisele, being a disk, interfaces

with the disk drive magnetically through a read-write head, not through a connector or through

circuitry.

At the interview, applicants' representative used samples of the prior art device and

applicants' claimed invention to make the above arguments to the Examiner. After viewing the

samples, the Examiner stated that he understood the arguments and would consider them in

detail when presented with an Amendment and after an additional prior art search.

8

Serial No.: 10/516,464

Docket No.: 28951.2183

1. Applicants have amended claims 16, 26 and 28 mooting the rejection under 35 U.S.C.

§112, second paragraph.

2. Claims 16 and 25 were rejected under 35 U.S.C. §102(b) over Eisele et al. U.S. Patent

6,089,459.

Eisele discloses a smart diskette device that is adaptable to receive a card. Eisele's

diskette device is adapted to receive a mini-chip card 118; see Eisele Figure 11. Eisele's mini-

chip card 118 is inserted orthogonally to the direction of insertion of the diskette into the disk

drive. However, Eisele's main card is a diskette, not an adapter for a smaller card. Chip card

118 is coupled via a wire to processor 116 that is in diskette 1171; see Eisele's Figure 11a and

11b. Eisle's diskette device communicates with a disk drive read/write head by means of a

magnetic transducer 510; see Eisle col. 9, lines 62-67. Eisle's diskette device communicates

with the disk drive magnetically only. Thus, Eisle does not disclose a circuit board within the

adapter body for electrically connecting the card receiver and the compact memory card, as

claimed by applicants.

Still further, Eisle's diskette device has a connector 119 for connecting minichip card 118

to the diskette device. Since Eisle's diskette device communicates magnetically with the disk

drive through the use of magnetic transducer 510 and a read/write head, Eisle therefore does not

disclose a first connector for electrically connecting the card adapter to the card receiver, as

claimed by applicants.

9

Serial No.: 10/516,464 Docket No.: 28951.2183

For all of the foregoing reasons, Eisele does <u>not</u> disclose all elements of applicants' claimed invention and therefore is not a proper basis for a §102 rejection of applicants' claims. Nor is there any disclosure or teaching in Eisele which would have suggested applicants' claimed invention to one of ordinary skill in this art. Thus, reconsideration and withdrawal of this rejection, and allowance of claims 16 and 25, are respectfully requested.

3. Claims 17-24 and 26-30 were rejected under 35 U.S.C. §103(a) over Eisele and Mizutani et al. U.S. Patent 5,777,275.

Claims 17-24, 26 and 27, which depend upon claims 16 and 25, respectively, and claims 28-30, are allowable for at least the reasons discussed above with respect to claims 16 and 25.

Mizutani does not disclose what is lacking in Eisele. Mizutani discloses a bendable circuit board, but <u>not</u> a circuit board within an adapter body for electrically connecting the card receiver and the compact memory card, <u>nor</u> a first connector for electrically connecting the card adapter to the card receiver, as claimed by applicants.

For all of the foregoing reasons, there is no disclosure or teaching in either of Eisele or Mizutani that would have suggested applicants' claimed invention to one of ordinary skill in this art. Further, there is no disclosure or teaching in either Eisele or Mizutani that would have suggested the desirability of combining any portions thereof effectively to anticipate or suggest applicants' claimed invention. Withdrawal of this rejection of claims 17-24 and 26-30, and allowance of the same are therefore respectfully requested.

Serial No.: 10/516,464

Docket No.: 28951.2183

Accordingly, this application is now fully in condition for allowance and a notice to that effect is respectfully requested. The PTO is hereby authorized to charge/credit any fee deficiencies or overpayments to Deposit Account No. 19-4293 (Order No. 28971.2183). If further amendments would place this application in even better condition for issue, the Examiner

is invited to call applicants' undersigned attorney at the number listed below.

Respectfully submitted,

Date: November 22, 2006

Roger W. Parkhurst, Reg. No. 25,177

Tyson Y. Winarski, Reg. No. 41,381

STEPTOE & JOHNSON LLP 1330 Connecticut Avenue, NW

Washington, DC 20036

Tel: 202-429-3000 Fax: 202-429-3902 RWP/TYW:mnl